

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT D. DeMASTER, ALEXANDER R. MITKA,
JOHN V. NOWICKI, ALEXANDER S. SINCLAIR, RICHARD E. SKARE,
and MARK W. WEAVERS

Appeal No. 97-3926
Application 08/481,091¹

ON BRIEF

Before MARTIN, FLEMING, and DIXON, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed June 7, 1996, which is identified as a division of Serial No. 08/295,225, filed August 24, 1994, which is identified as a continuation of Serial No. 08/035,744, filed March 23, 1993.

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 35-43. We affirm-in-part.

A. The invention

The invention is a method of using a cleaning tape to clean the head of a VCR. As shown in Figure 3, the cleaning tape includes a microabrasive non-recordable leader portion 36 for cleaning the capstan 18 and pressure roller 20 (see Fig. 5) and a recordable scrubbing portion 34, which includes audio/video segments 58, 60, 62, 64, and 66 (Fig. 6) containing instructions for use of the cleaning tape (Spec. at 12, line 10 to p. 13, line 18). Each of segments 58, 60, 62, and 64, which correspond to different cleaning sessions, instructs the user to stop the tape and eject it without rewinding. Segment 66, which corresponds to another cleaning session, instructs the user to rewind the tape in the "rewind scan" (also called "reverse search") mode before ejecting it from the VCR. When the tape has been completely rewound to the position shown in Figure 5, the abrasive portion of the now stationary tape is engaged by the rotating capstan 18, which is thereby cleaned by the tape. Consequently, the head

is cleaned more often than the capstan (Spec. at 12, lines 2-9).

We note that although numeral 16 in Figures 1 and 2 appears to designate the drum rather than the unnumbered heads which are carried by the drum, the specification explains (at 8, lines 14-17) that "head 16 refers to all of the heads, whether video, audio, erase, or otherwise, regardless of the type of head and whether a plurality of heads are included on a single drum or head assembly."

B. The claims

The independent claims, i.e., claims 35 and 38, are reproduced below:

35. A method of using a cleaning cassette having tape with scrubbing material and magnetic material prerecorded with audio sounds and video images which, when the cleaning cassette is inserted into the VCR, convey instructions to an operator for using the cleaning cassette, wherein a first set of instructions is repeated serially in segments to form a plurality of first sets of instructions, each of which is used in a separate cleaning episode, and after the last repeated segment having the first set of instructions a different second set of instructions is conveyed, wherein the magnetic material and the scrubbing material are located in the same length of tape portion to permit simultaneous head cleaning and playing of recorded signals, wherein the method comprises the steps of:

inserting the cleaning cassette into the VCR and playing the tape for one entire first set of instructions; and

removing the cleaning cassette after the first set of instructions is complete.

38. A method of cleaning a tape path of a VCR having a head comprising the steps of:

loading into the VCR a cleaning cassette comprising a tape having a front side, a back side, scrubbing material and magnetic material prerecorded with audio sounds and video images located in the same length of tape portion on the front side of the tape to permit simultaneous head cleaning and playing of recorded signals, and scrubbing material on the back side of the tape;

operating the VCR in the play mode for a period of time;

operating the VCR in the reverse scan mode for a period of time; and

ejecting the cleaning cassette from the VCR.

C. The references and rejections

The rejections are based on the following U.S. patents:

Nowicki et al. (Nowicki)	3,978,520	Aug.
		31, 1976

Siddiq	4,893,209	Jan. 9,
		1990

Claims 35-37 stand rejected under 35 U.S.C. § 102(b) as anticipated by Siddiq.

Claims 35-43 stand rejected under § 103 for obviousness over Nowicki in view of Siddiq.

D. Level of skill

The level of skill in the art is represented by the references. See In re Oelrich, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978) ("the PTO usually must evaluate both the scope and content of the prior art and the level of ordinary skill solely on the cold words of the literature"); In re GPAC Inc., 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995) (Board did not err in adopting the approach that the level of skill in the art was best determined by the references of record).

E. The merits of the § 102(b) rejection

Anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986).

Although the examiner states (Answer at 3) that he is relying on Siddiq's Figure 4, it is clear from his reference "two set[s] of instructions" that he is actually relying on Figure 5, which shows a cleaning tape including, in series, a first diagnostic/instructional segment 6, a transition segment

26, a cleaning segment 4, a polishing segment 18, and a second diagnostic/instructional segment 34. Although not expressly stated in Siddiq, appellants' brief² concedes (at 7, lines 1-4) that there is cleaning material on the back of the Siddiq tape: "The cleaning material on the back of the Siddiq tape does not permit simultaneous head cleaning and playback because the back of the tape never contacts the heads" (Brief at 7, lines 1-4).³

The first limitation at issue is claim 35's recitation that "the magnetic material and the scrubbing material are located in the same length of tape portion to permit simultaneous head cleaning and playing of recorded signals." The examiner contends that

[t]he cleaning and playing of Siddiq is simultaneous because the time period during which the cleaning and

² All references to the brief are to the replacement brief (paper No. 14).

³ The basis for this admission is not clear. Perhaps it is based on appellants' knowledge of the details of the commercially available homogenous polymeric tape material Siddiq suggests for use as the cleaning segments, i.e., Melinex 377/75 and 378/75, made by ICI Americas Inc., a homogenous polymeric tape having a matte finish with a roughness of about 0.5 Fm (col. 3, lines 35-41).

playing take place has not been specified and the components [being] cleaned also have not been specified. The transport components of Siddiq are permitted to be cleaned at the exact same time as the playing of recorded signals since the portion of tape with the recorded signals will contact the magnetic head when the cleaning portion contacts a transport component. See column 2, lines 15-16 of Siddiq. [Answer at 3.]

These cited lines in Siddiq state that "one or more cleaning segments clean the magnetic head, and other transport components." The examiner's contention that the component being cleaned is not specified in the claim is incorrect. As appellants correctly note (Brief at 6), the claim language in question calls for "simultaneous head cleaning and playing of recorded signals" (appellants' emphasis).

At pages 6 and 7 of the Answer, the examiner for the first time offers an alternative rationale for reading this claim language on Siddiq. Citing a dictionary definition of "simultaneous" to mean "at the same time" and a dictionary definition of "time" to mean "[a]n interval separating two points. . . ," the examiner contends that the claim language is broad enough to read on a length of tape which includes successive diagnostic/informational and cleaning segments. Although this new rationale has not been addressed by appellants, who did not file a reply brief, we have considered

its merits and conclude that the examiner's construction of the language in question is strained and unreasonable. Given its broadest reasonable construction, the phrase "simultaneous head cleaning and playing of recorded signals" requires that at least part of the head cleaning operation and the playing of recorded signals occur at the same instant in time, which does not occur in Siddiq.

Claim 35 also recites another limitation which appellants argue (Brief at 7) is not disclosed in Siddiq, i.e., the requirement that the second set of instructions be different from the first set of instructions. The examiner addressed this limitation as follows:

Figure 5 shows [diagnostic/instructional] segments 6 and 34. First of all the fact that [they] are separated by cleaning and polishing segments clearly shows that they are different. If the[y] were not different the[re] would be no reason to provide separation. Secondly, Siddiq provides different numbers to further distinguish the two segments from each other. Thirdly, column 4, lines 49-52 states the following: "The use of separated diagnostic/instructional segments 6, 34 maybe [sic, Siddiq's error] useful to provide the user with an almost instantaneous indication of cleaning effectiveness using before and after views". [Answer at 7-8.]

The foregoing facts are not sufficient to establish that the information contained in segments 6 and 34 is inherently, i.e., necessarily, different, as is required to establish

anticipation. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

For the foregoing reasons, the § 102(b) rejection is reversed with respect to claim 35 and its dependent claims 36 and 37.

F. The merits of the § 103 rejection

In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998), explains that

[t]o reject claims in an application under section 103, an examiner must show an un rebutted prima facie case of obviousness. See In re Deuel, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness. See id.

Nowicki's cleaning tape employs an abrasive magnetic coating which permits simultaneous head cleaning and playback

of recorded information (col. 2, lines 13-20), as required by claims 35 and 38.⁴ Nowicki explains:

The cassette is inserted for playback in a vtr machine having badly fouled heads. The display at the video monitor is initially completely haphazard, non-synchronized, noisy and snowy. Within about 10 seconds the display suddenly clarifies and synchronizes to present a clear, well-defined color test bar pattern, whereupon the machine is immediately stopped. [Col. 3, line 50 to col. 4, line 2.]

Regarding claim 35, the examiner, conceding that Nowicki fails to disclose a plurality of first sets of instructions, argues that "[i]t would have been obvious . . . to provide Nowicki et al[.] with a plurality of sets of instructions as taught by Siddiq" because the artisan "would have been motivated to provide a plurality of sets of instructions so that different diagnostic information that pertains to different tape components is able to be conveyed to the user" (Answer at 4-5). Appellants respond that

Siddiq does not disclose a first set of instructions to be repeated serially followed by a second different set of instructions as recited in the claims. The two segments in Figure 5 of Siddiq are not used to provide different instructions. There is no mention or any

⁴ Siddiq describes his cleaning tape, which does not provide simultaneous head cleaning and playback, as an improvement over Nowicki's cleaning tape (Siddiq, col. 1, lines 23-41).

suggestion anywhere in Siddiq that two different segments are used to provide two different sets of instructions. [Brief at 7.]

We agree with the examiner that the separation of segments 6 and 34 by cleaning and polishing segments 4 and 18 would have been understood by the artisan as suggesting that segments 6 and 34 can be used to display different sets of instructions (Answer at 7-8). More particularly, in view of Siddiq's statement that "[t]he use of separated diagnostic/instructional segments 6, 34 maybe [sic] useful to provide the user with an almost instantaneous indication of cleaning effectiveness using before and after views" (col. 4, lines 49-52), it would have been obvious to use segment 6 to show a test pattern and instruct the user that the cleaning operation is about to begin and segment 34 to repeat the test pattern and advise the user that the cleaning operation is over. However, although the examiner noted (Answer at 7) appellants' contention that the references fail to suggest serially repeated instructions, he did explain why it would have been obvious to serially repeat the first set of first instructions and follow them with a different second set of instructions, as recited in claim 35. The § 103 rejection

therefore is reversed as to claim 35 and its dependent claims 36 and 37.

Independent claim 38 calls for the tape to have scrubbing material and magnetic material on the front side and scrubbing material on the back side. As evidence of the obviousness of providing the back side of Nowicki's tape with scrubbing material, the examiner cites Siddiq's statement that "[t]he one or more cleaning segments clean the magnetic head, and other transport components" (col. 2, lines 14-16), which the examiner construes as "disclos[ing] that Siddiq has scrubbing material on the back side of the tape due to the fact that some transport components, i.e., the pinch roller or the capstan, only contact the back side of the tape" (Answer at 8). We agree with appellants that the examiner is reading too much into Siddiq's statement, which does not say that the head and all transport components are cleaned. However, the examiner's reliance on that statement is unnecessary in view of appellants' above-noted admission that there is a cleaning material on the back side of Siddiq's cleaning segments (Brief at 7, lines 1-4). As appellants have made no other argument for the patentability of claim 38, we are affirming the § 103

rejection with respect to that claim and dependent claims 39-41 and 43, which are not separately argued.

Dependent claim 42, which is separately argued, specifies that the recorded instructional information comprises (a) a plurality of first similar recorded segments each of which instructs a user to first operate the VCR in the play mode, then stop the VCR and eject the cassette without rewinding, and (b) a second recorded segment which follows the last of the first similar recorded segments which instructs the user to operate the VCR in the play mode and then operate the VCR in the reverse scan mode. The rejection of this claim is reversed because the examiner has not explained how these limitations are satisfied by the proposed combination of reference teachings.

Summarizing, the § 102(b) rejection of claims 35-37 is reversed, the § 103 rejection of claims 38-41 and 43 is affirmed, and the § 103 rejection of claim 42 is reversed.

Appeal No. 97-3926
Application 08/481,091

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

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JOHN C. MARTIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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